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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,653	12/21/2000	Michael Hannington	AVERP2808USA	7502

7590 11/06/2002  
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1621 Euclid Avenue  
Cleveland, OH 44115

EXAMINER
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EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/06/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,653

Applicant(s)

HANNINGTON, MICHAEL

Examiner

Brian P. Egan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-33, 35-40, 42, 43 and 46-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-33, 35-40, 42, 43 and 46-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method of making an adhesive article, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

### ***Claim Objections***

2. Claims 44-45 have been cancelled by the applicant in Paper No. 12, thereby rendering the claim objection of the aforementioned claims in the previous office action, Paper No. 10, moot. Therefore, the Examiner has withdrawn the claim objection.

## **New Rejection**

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The 35 U.S.C. 112, first paragraph rejection of Claims 31-59 from the previous office action, Paper No. 10, has been withdrawn by the Examiner. The applicant has given clear

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explanation to the “route of egress” that was initially non-enabling to the Examiner on page 17, paragraph 46 of the Specification and further detailed in the applicants remarks in Paper No. 12.

6. Claims 35, and 59-60 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The aforementioned claims contain method limitations that are given little to no patentable weight, absent unexpected results, in article claims. Specifically, Claim 35 recites the limitation that the “pattern of non-adhesive material forms is applied by printing,” Claim 59 recites the limitation that “wherein the thickness of the non-adhesive material forms is sufficient enough to cause deformation of the facestock upon application of the adhesive article to the substrate,” and Claim 60 recites the limitation “wherein the pattern of non-adhesive material forms is applied by vacuum metallization or sputtering.” Proper clarification and/or correction are required.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Pursuant to the applicants amendment as well as his remarks in Paper No. 12, the Examiner has withdrawn all of the 35 U.S.C. 102 (b) and (e) rejections from the previous office action, Paper No. 10.

9. Claims 31-33, 35, 37, 42-43, 49-53, 55, 59-62, 66-72, and 74 are rejected under 35 U.S.C. 102(b) as being unpatentable over Calhoun et al. (#5,141,790).

Calhoun et al. disclose an adhesive article comprising a release liner having a top release surface and a bottom surface (Fig. 1, #12), a continuous layer of adhesive having a bottom surface and a top surface and end edges wherein the bottom surface of the adhesive is adhered to the top release surface of the release liner (Fig. 1, #17), and a pattern of non-adhesive material forms embedded into the top release surface of the release liner such that the non-adhesive material forms have a top surface wherein the top surface of the material forms is even with or below the plane of the top release surface of the release liner (Fig. 1, #15). A facestock is applied to the top surface of the adhesive layer (Fig. 1, #18). The non-adhesive material forms have an average thickness between 30 nanometers and 100 micrometers (Col. 3, lines 48-49). The pattern of non-adhesive material forms comprises a plurality of dots (see Fig. 1). The adhesive layer comprises a pressure sensitive adhesive (see Abstract) and is heat activated at high temperatures wherein it melts to form bonds with the non-adhesive material forms (Col. 4, lines 15-20). The release liner has a random textured surface wherein the release liner and adhesive layer have complementary patterned finishes (see Fig. 1). The release liner further comprises a paper substrate that is coated with a release coating (Col. 7, lines 25-31).

Although Calhoun et al. fail to disclose the method of applying the non-adhesive material forms, i.e., by printing, sputtering, or vacuum metallization, the method of forming the device is

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not germane to the issue of patentability of the device itself. Therefore, these limitations have not been given patentable weight in the absence of unexpected results.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 31-33, 35-40, 42, 46, 49-52, 55, 59-67, 69-71, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rusincovitch et al. (#5,676,787).

Rusincovitch teaches an adhesive article (Fig. 5) comprising a release liner having a release surface and a back surface (Col. 2, lines 42-45), a continuous layer of a pressure sensitive adhesive having a front surface and a back surface and end edges (Fig. 4, #16; Col. 9, lines 3-9) wherein the front surface of the adhesive is adhered to the release surface of the release liner ("Then the decorative sheet having the release layer and spacers on one side and PSA on its other side is rolled up to form a roll. This causes the spacers and release layer to contact the PSA." Col. 2, lines 49-52), and a pattern of non-adhesive material forms embedded into the release surface of the release liner wherein the non-adhesive material forms have top surfaces (Fig. 4B). The back surface of the release liner has a release coating thereon (Col. 11, line 28-35). The non-adhesive material forms have a thickness of 0.05 mils to 0.50 mils (5 $\mu$ -500 $\mu$ ; i.e. within the range of 30nm- 100 $\mu$ ; Col. 9, lines 51-54). A facestock is applied to the back surface of the aforementioned adhesive layer (Figs. 1-2, #12). The non-adhesive material forms are applied by

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printing (Col. 2, lines 43-45) in a pattern comprising a plurality of dots, lines, or combinations thereof (Fig. 8A and 8B; Col. 9, lines 35-42). Furthermore, the thickness of the non-adhesive material forms is sufficient enough to cause deformation of the facestock upon application of the adhesive article to a substrate (Col. 9, lines 26-33).

Furthermore, Rusincovitch et al. teach that anything that can be used as the ink on a printing machine can be used for fabricating the spacers so long as it is not sticky or tacky upon drying so that the spacers can slide over the surface of a wall. Thus, any plastic, including resinous material, which can be placed in solution, dispersion, or emulsion, and which is not sticky or tacky on drying would be used. The spacers can be made of organic polymeric material such as polyurethane, polyvinyl alcohol, acrylic polymers, acetate, polyethylene, polypropylene, or polystyrene and the like (Col. 10, lines 30-39). Therefore, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have used either UV curable ink or coalesced ink in order to obtain the inherent non-adhesive properties of both UV-cured and coalesced inks.

Rusincovitch et al. also teach that the size, location, repeating, design, and surface area of the spacers can be varied to match or register with the printed or embossed patterns on the face of the decorative sheet. These aforementioned properties are variable for the purpose of significantly reducing the noticeability of the spacers. The spacers on the back of the decorative sheet can be circles, diamonds, squares, ellipses, rectangles, or other shapes, including irregular shapes such as wavy lines (Col. 9, lines 35-42). Rusincovitch et al. teach that the spacers cover from 5-50% of the back surface (Col. 9, lines 55-57) and that the percent of back surface area occupied by the spacers are modified to allow the decorative sheet to be slidably movable on the

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surface of a wall (Col. 9, lines 15-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have modified Rusincovitch et al. to include a plurality of lines, either in vertical, horizontal, or grid form depending on the printed or embossed pattern on the face of the decorative sheet and therefore creating either a random or patterned textured surface, of non-adhesive material forms ("spacers") with variable thickness, width, and percent coverage of the back surface in order to provide an adhesive article that is slidably movable on the surface of a wall while at the same time having a reduced noticeability of the spacers for aesthetic reasons.

Rusincovitch et al. teach that after the non-adhesive material forms are applied to the release liner surface, the release liner is passed through a dryer and fed through a series of rollers – all of which is prior to the application of the adhesive layer (Col. 5, line 66 to Col. 6, line 10). The Examiner agrees with the applicants contention that Rusincovitch et al. teach the non-adhesive forms protrude from the release liner surface (Col. 6, lines 57-61), but this embodiment is found immediately after the printing operation and prior to the passage through a series of rollers. As detailed by the applicants on page 18, paragraph [0047] of the specification, "embedding may be carried out using pressure and/or heated rollers or a platen, whereby the non-adhesive material is pressed into the release liner." Therefore, in the absence of unexpected results, Rusincovitch et al. teach an equivalent method of forming the release liner and the non-adhesive material forms would inherently become embedded to a height equal to or below the top plane of the release liner given the equivalence in the method of forming the release liner, i.e., the use of rollers prior to the application of the adhesive layer.



Note that although Rusincovitch et al. teach the method of forming the non-adhesive material forms, i.e., by printing, the method limitations in the applicants claims, i.e., printing, vacuum metallization, and sputtering, are not germane to the issue of patentability of the device itself and therefore the method limitations have not been given patentable weight in the absence of unexpected results.

12. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (#5,141,790) in view of GB #1,511,060.

Calhoun et al. teach an adhesive article as detailed above. Although Calhoun et al. teach that the non-adhesive material forms are substantially uniformly distributed, Calhoun et al. fail to teach that the substantially uniform distribution can be in the form of a grid pattern which intersects at least 50% of the lines intersect the edges of the article.

GB '060, however, teaches an air impermeable adhesive sheet, provided on its back surface with a heat and pressure-sensitive adhesive, wherein the surface of the adhesive layer is provided with one or more elongate ridges or recesses and wherein at least one end of such ridge or recess intersects the end edge of the sheet. Further, GB '060 teaches that a grid pattern (Fig. 5-3) of parallel straight lines can be used for the purpose of effectively achieving the air egressing effect (p.2, lines 116-128). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicant's invention was made to have used a grid pattern in an adhesive article for the purpose of achieving the air egressing effect as taught by GB '060.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have modified Calhoun et al. to include a grid pattern as

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taught by GB '060 in order to allow the non-adhesive material forms to form a pattern that can effectively achieve the air egressing effect.

The applicants primary contention in relation to the teachings of GB '060 is that GB '060 would actually discourage the use of non-adhesive material forms since the patterns must collapse during the application. It is notoriously well known in the repositionable adhesive article art, however, that microspheres as used by Calhoun et al. are made such that they collapse (and break in the instance of glass microspheres) once the adhesive article has been repositioned to its desired substrate such that the adhesive layer achieves a substantially uniform thickness. Therefore, the teachings of GB '060 are in line with those of Calhoun et al. Furthermore, the applicant contends that the application of heat is required for degassing of the adhesive article which in turn collapses the adhesive tape. This aforementioned process limitation is irrelevant to the overall structure taught by GB '060. Whether the adhesive article is collapsed via heat or via pressure (such as the application of enough pressure to deform or crush the microspheres) is not relevant – in both instances, a route of air egress is provided and therefore the structural limitations met.

13. Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (#5,141,790) in view of Plamthottam et al. (#5,180,635).

Calhoun et al. teach an adhesive article as detailed above. Calhoun et al. further teach that the non-adhesive material forms may be glass, ceramic, metallic, or polymeric microspheres (Col. 3, lines 29-32) although Calhoun fails to teach whether these aforementioned materials include porous elastomeric microspheres.

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Plamthottam et al., however, teach a high-performance adhesive tape comprising microspheres which may be made of any suitable material including glass, ceramic, polymeric, and carbon materials (Col. 4, lines 58-61) all of which may be solid, hollow or porous, and rigid or elastomeric (Col. 4, lines 57-58) depending on the desired end product. Plamthottam et al. teach the use of microspheres for the purpose of reducing the density of the carrier layers, improving peel adhesion and thereby improving conformability, and also improving the strength properties of the tape (Col. 4, lines 51-56). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided an adhesive article with non-adhesive, porous elastomeric microspheres for the purpose of reducing the density of the carrier layers, improving peel adhesion and thereby improving conformability, and also improving the strength properties of the tape as taught by Plamthottam et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Calhoun et al. to include porous elastomeric microspheres as taught by Plamthottam et al. in order to reduce the density of the carrier layers, improve peel adhesion and thereby improve conformability, and also improve the strength properties of the adhesive article.

14. Claims 54, 56-58, 73, and 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (#5,141,790) in view of Calhoun et al. (#5,585,178).

Calhoun et al. ('790) teach an adhesive article as detailed above. Calhoun et al. ('790) fail to teach a second adhesive layer adhered to the back surface of the release liner wherein a facestock is adhered to the second (or first) adhesive.

Calhoun et al. ('178), however, teach a composite adhesive tape with two adhesive layers, the second adhesive being adhered to the back side of the release liner (See Fig. 4). The two layered adhesive is used for the purpose of having two adhesives providing different properties – i.e., such that the first adhesive can have a repositionable property and the second adhesive can be used to build bond strength during aging when adhered to a substrate/facestock. (Col. 3, lines 30-35). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicant's invention was made to have used multiple layers of adhesive in an adhesive article for the purpose of providing varying properties to the article wherein one adhesive provides repositionability and the second adhesive builds bond strength through aging as taught by Calhoun et al. ('178).

Therefore, it would have been obvious to one of ordinary skill at the time applicant's invention was made to have modified Calhoun et al. ('790) to include a second layer of adhesive as taught by Calhoun et al. ('178) in order to provide an adhesive article with varying properties via the use of multiple adhesives wherein one adhesive provides the article with repositionability and the other builds bond strength through aging and is bonded to a facestock.

#### ***Response to Remarks***

15. Applicant's arguments with respect to claims 31-59 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE

November 4, 2002



HAROLD PYON  
SUPERVISORY PATENT EXAMINER

1772

11/4/02

Form PTO-1449 (Modified)

Atty Docket No.

Serial No.

AVERP2808USA

09/742,653

LIST OF PATENTS AND PUBLICATIONS  
FOR APPLICANT'S  
INFORMATION DISCLOSURE STATEMENT

Applicant:

Michael Hannington et al.

Filing Date

December 21, 2000

Group

~~7534~~ 1772

(Use several sheets if necessary)

## U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date (MM/YYYY)	Name	Class	Sub-class	Filing Date if Appropriate
BPE	2,191,704	02/27/40	Bennett	91	68	
BPE	4,971,854	11/20/90	Hinishi et al.	428	195	

## FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date (MM/YYYY)	Country	Class	Sub-class	Translation	
						Yes	No

## OTHER ART

Examiner Initial	Author, Title, Date, Pertinent Pages, etc.

EXAMINER

B. P. Eg

DATE CONSIDERED

11/1/02

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

## Information Disclosure Statement PTO-1449 (Modified)

The identification of any reference is not intended to be, and should not be understood as being, an admission that such publication, in fact, constitutes "prior art" within the meaning of applicable law since, for example, a given reference may have a later effective date than first seems apparent or the reference may have an effective date which can be antedated. The "prior art" status of any reference is a matter to be resolved during prosecution.

R:\Heidi\Avery\2808\2808 IDS and 1449.wpd (IDS1449.FRM) (2/97)